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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/675,141	09/29/2000	Takashi Kawana	862.C2015	2807
5514	7590	01/13/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO			LAMB, TWYLER MARIE	
30 ROCKEFELLER PLAZA			ART UNIT	
NEW YORK, NY 10112			PAPER NUMBER	

2622

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/675,141

Applicant(s)

KAWANA, TAKASHI

Examiner

Twyler M. Lamb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-9,11-17,19,20,22-33,35,36 and 38-48 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3-9,11-16,20,22,24,26,28,30,32,36,38,40,42,44,46 and 48 is/are allowed.
- 6) ☒ Claim(s) 17, 19, 23, 25, 27, 29, 31, 33, 35, 39, 41, 43, 45 and 47 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 17, 19, 23, 25, 27, 29, 31, 33, 35, 39, 41, 43, 45 and 47 are rejected under 35 U.S.C. 102(e) as being anticipated by Kawana (5,832,186)

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

With regard to claims 17 and 33, Kawana discloses an image forming apparatus (Figure 1, laser-beam printer) for forming an image of multilevel image data (col 6, lines 33-39), comprising: driving means (image processor 305) for driving an image forming element (semiconductor laser 306) for image formation (col 2, lines 56-65); additional data generating means (trace pattern processor 53) for generating a digital signal string based on predetermined additional data (col 10, lines 24-31), wherein said driving means has an input terminal for forcedly controlling light emission of said image forming element, and a digital signal string based on the additional data is input to said input terminal of said additional data generating means (col 7, line 66 – col 8, line 22); wherein said input terminal forcedly turns on or off light emission of said image forming element (col 7, line 66 – col 8, line 22).

With regard to claims 19 and 35, Kawana also discloses wherein said digital signal string related to the multilevel image data and said digital signal string based on predetermined additional data are generated by different clock generation means (col 10, line 63 – col 11, line 18).

With regard to claims 23 and 39, Kawana also discloses wherein the additional data is based on information for specifying said image forming apparatus (col 10, lines 24-31).

With regard to claims 25 and 41, Kawana also discloses further comprising means for generating horizontal scan position information and vertical scan position information in printing scan by said image forming element, wherein said additional data generating means generates a digital signal string based on the additional data on the

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basis of the horizontal scan position information and the vertical scan position information (col 8, lines 37-40; col 6, lines 42-45).

With regard to claims 27 and 43, Kawana also discloses wherein said additional data generating means comprises means for inputting information of a position on the image to which the additional data is to be added (col 7, lines 16-65).

With regard to claims 29 and 45, Kawana also discloses wherein the multilevel data includes data of at least yellow, cyan, and magenta, and said additional data generating means generates a digital signal string based on the additional data only for a digital signal string of the multilevel image data pertaining to yellow (col 7, lines 1-39).

With regard to claims 31 and 47, Kawana also discloses wherein said image forming element is a light-emitting element (col 1, lines 43-46).

Allowable Subject Matter

3. Claims 1, 3-9, 11-16, 20, 22, 24, 26, 28, 30, 32, 36, 38, 40, 42, 44, 46 and 48 are allowed.

Response to Arguments

4. Applicant's arguments filed 7/8/04 have been fully considered but they are not persuasive.

Applicant argues Kawana fails to teach Kawana adds a density value to a density value of multilevel image data. That patent does not disclose or suggest any input terminal that forcedly turns on or off light emission of an image forming element.

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Kawana discloses any input terminal that forcedly turns on or off light emission of an image forming element (col 7, line 66 – col 8, line 22).

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Twyler M. Lamb whose telephone number is 703-308-8823. The examiner can normally be reached on M-Thurs 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 703-305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'T. Lamb', with a stylized flourish at the end.

Twyler M. Lamb
Examiner
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